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08/809,340 05/06/97 PADOVANI

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EXAMINER

MACKEY, J

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/809,340

Applicant(s)

PADOVANI

Examiner

James Mackey

Group Art Unit

1722



☒ Responsive to communication(s) filed on Nov 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1 and 3-42 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 3-42 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Responsive to a telephone communication with Applicant's representative, Mr. Richard Berg, on April 26, 2000; requesting reconsideration of the finality of the last Office Action, and in view of the withdrawal of the rejection of claims 31-41 under 35 USC 102(b) as being "clearly anticipated" by International Application Publication WO94/15863, as described in the previous Office Action (Paper No. 17), **the finality of the last Office Action, Paper No. 21, is hereby withdrawn.** A complete action on the merits, replacing the last Office Action (Paper No. 21), follows hereinbelow:

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

3. Applicant should update the status of the parent application S.N. 08/481,458 (i.e., "now abandoned") in the insertion at the beginning of the specification.

4. Claims 1, 6 and 14 are objected to because of the following informalities: In claim 1, lines 8 and 10, "receving" is misspelled; in claim 6, line 6, "to transferring it to" is grammatically

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incorrect (it should read --transferring it to--); and claim 14, line 5, “theremoformed” is misspelled. Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-30, 34-35, 39 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, “a retention surface” on line 8 and “at least one retention surface” on line 9 are indefinite as to how they relate to one another. Claims 26-30 are rejected due to their dependence on indefinite claim 25.

In claims 28, 34 and 39, “intersect each” is unclear and indefinite (each what?).

In claim 42, line 2, “plate-like” is of indefinite scope, since the scope of the suffix “like” cannot be determined (see MPEP § 2173.05(d)).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1 and 4-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2,263,660 taken together with International Application Publication WO94/15863 (Figures 11-15).

GB '660 teaches the thermoforming apparatus substantially as claimed, including extraction heads PA, 26, 27 for extracting thermoformed articles from the female die and transferring the articles to conveying templates on a conveyor (see especially Figures 14-23 and 32). GB '660 further teaches that the extraction head and the conveying template have receiving seats for the thermoformed articles, but does not teach that the receiving seat is defined by two annular surfaces defining an annular shoulder therebetween. WO94/15863 teaches a thermoforming apparatus including an extraction head having receiving seats defined by two annular surfaces defining an annular shoulder therebetween. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify GB '660 by providing the receiving seats of either the extraction head or the conveying template as the receiving seat having an annular shoulder as disclosed in WO94/15863, in order to more securely attach the thermoformed articles to the extraction head and/or the conveying template. It would have been further obvious to a skilled artisan to have provided the conveyors of GB '660 as conventional chain conveyors (note Figure 22), and obvious to have provided the receiving seats with either deformable collar or ratchets/arrests as taught in WO94/15863 (see Figures 2-3 and 5-10), in order to more accurately locate and retain the thermoformed articles; note also the ratchets/arrests taught in GB '660 at Figures 24, 26 and 28.

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9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '660 taken together with WO94/15863, as applied to claims above, and further in view of Beyer-Olsen et al. (U.S. Patent 3,966,386).

GB '660 does not teach a carousel conveyor having a plurality of arms. Beyer-Olsen et al. teach an apparatus for removing molded articles from a molding device comprising a carousel conveyor having a plurality of arms, each arm being provided with a means for gripping the molded article and moving said article to another location. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify GB '660 by providing the conveyor as a carousel conveyor, as disclosed in Beyer-Olsen et al., in order to facilitate the conveying of the molded articles.

10. Claims 1, 4 and 25-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padovani (U.S. Patent 4,560,339; Figure 3) in view of German Patent 3,928,301.

Padovani '339 teaches a thermoforming apparatus comprising sets of male/female dies (as clearly shown in Figure 1), extraction pick-up means 12 including a plate member having a recess for engaging with the thermoformed articles for withdrawing the articles and transferring the articles to a receiving conveyor 42 (as clearly shown in Figure 3). Padovani '339 does not teach the extraction pick-up means including a receiving hole/cavity having an interior dimension which is smallest in a region remote from the exterior surface of the extraction pick-up means to define a shoulder for holding the article (claims 25, 31 and 37), or wherein the receiving hole is defined by two annular surfaces reamed in opposite directions and defining between them an equatorial

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shoulder for engaging and positioning the article (claim 1). German '301 teaches a thermoforming apparatus including an extraction pick-up means comprising a plate member having receiving holes each with an interior dimension which is smallest in a region remote from the exterior surface of the extraction pick-up means to define a shoulder for holding the article, the hole being defined by two annular surfaces defining an equatorial shoulder therebetween for engaging and positioning the article. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Padovani '339 by providing the extraction pick-up means as the extraction pick-up means disclosed in German '301 including receiving holes each having an interior shoulder, in order to more securely engage with the articles to be removed from the thermoforming machine. Note that while Padovani '339 does not explicitly teach a feeder (although note the recitation at column 3, line 43 concerning step-wise advancement of the sheet material being fed to the apparatus), such would have been obvious and well within the level of ordinary skill in the art in order to positively and automatically deliver the raw sheet material to the thermoforming machine.

11. Applicant's arguments filed Nov. 29, 1999, have been fully considered but they are not persuasive.

The rejection of claims 31-41 under 35 USC 102(b) as being "clearly anticipated" by International Application Publication WO94/15863 is withdrawn, since, upon review, WO94/15863 does not clearly teach a counterdie nor a feeder, and therefore said rejection was not proper.

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Applicant argues that the instant application is now a CIP of U.S. Application Serial No. 08/481,458, based on PCT/EP93/03700, which claims priority to a foreign application filed on Jan. 12, 1993, and therefore the claimed subject matter antedates the applied references. However, Applicant is entitled to the effective filing date of the parent application '458 only for those claims having claimed subject matter fully supported by the parent application '458. In the instant claims, the claimed subject matter of claims 1-30 and 42 is clearly not supported by the parent application '458, since nowhere in the parent application '458 is support found for an apparatus wherein "at least one of said extraction pick-up means and said conveying template including a receiving hole...each receiving hole being defined...an equatorial shoulder" as claimed in claim 1, nor is support found for an apparatus wherein "at least one of the extraction pick-up apparatus and the receiving conveying template including a retention surface...being defined by...a shoulder" as claimed in claim 25. Moreover, the claimed subject matter of claims 1 and 3-42 is not supported by the parent application '458, since nowhere in the parent application '458 is support found for an apparatus comprising a counterdie and a feeder (note that no feeder is described at all in the parent application '458, and the only references to what may be considered to be a counterdie--"male die"--is in the background of the invention, which does not describe the apparatus having the transfer pick-up means corresponding to the instant claims). Furthermore, the subject matter of various dependent claims 3-24 is not supported by the parent application '458, since nowhere in the parent application '458 is support found for the details of the conveying template and/or carousel downstream of the extraction pick-up apparatus, nor the



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chain conveyor, nor the work and/or treatment station, nor the plural templates, nor the truncated conical collar, nor the support shoulder between the receiving holes. Therefore, none of the instant claims is entitled to the effective filing date of the parent application '458.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 305-4251. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651. Any inquiry relating to the contents or papers filed in this application, other than issues of substance requiring the attention of the Examiner, should be directed to the Customer Service Office, Technology Center 1700, whose telephone number is (703) 306-5665.

MACKEY/jpm  
April 26, 2000

  
**JAMES MACKEY**  
**PRIMARY EXAMINER**  
**ART UNIT 1722**  
4/26/00